

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231, ON THE DATE INDICATED BELOW.

BY:

Emantha D. Helant

DATE: May 25, 1999

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------|--|---|
| In re: | Patent Application of Darwin J. Prockop <i>et al.</i> | : Group Art Unit 1651 : : : |
| Appln. No: | 08/913,918 | : Examiner: Jean C. Witz : : |
| Filed: | December 8, 1997 | : : Attorney Docket |
| Title: | ISOLATED STROMAL CELLS AND METHODS OF USING SAME | : No. 9855-14U1 : (TJU-1857) |

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Restriction Requirement dated March 30, 1999 (Paper No. 7), issued in connection with the above-identified application, Applicants hereby elect to prosecute the claims of Group V, claims 37 and 38 (incorrectly indicated as 37-39 in the Restriction Requirement), without traverse.

This response is being timely filed in view of the accompanying Petition for a one month extension of time, which extends the time for a response to the Restriction Requirement through and including June 1, 1999 (May 30, 1999, being a Sunday and May 31, 1999, being Memorial Day).

A Preliminary Amendment accompanies this response, which adds dependent claims 55 to 68 to the application for the Examiner's consideration.

Applicants respectfully point out that the Examiner, who is also the Authorized Officer regarding International Application PCT/US96/04407 on which the instant application is based, has cited PCT Rules 13.1 and 13.2 instead of the appropriate section of the U.S. patent statute, *i.e.*, 35 U.S.C. § 121, in support of the Restriction Requirement. Nonetheless, in a good

faith effort to expedite prosecution in this matter, Applicants have elected to prosecute Group V, drawn to isolated stromal cells comprising a nucleotide sequence, without traverse.

Further, the Examiner has included claim 39, drawn to a method of treating a patient comprising a bone marrow transplant, in both Group I (claims 1-4, 6-11, and 39-44), drawn to a method of treating disease or condition with stromal cells, and Group V (claims 37-39), drawn to isolated stromal cells. Applicants assume that the Examiner has inadvertently included claim 39 in both Groups and that claim 39 is not included in Group V but is more properly included in Group I since the Examiner has restricted claims 40-44, which depend from claim 39, to Group I. Also, Group V, drawn to isolated stromal cells, is related to Group I, drawn to methods of using such cells, as product and process of use (MPEP § 806.05(h)) and claim 39 is drawn to a method of using the cells of claims 37 and 38. For these reasons, Applicants have selected Group V with the understanding that Group V consists of claims 37 and 38 and that claim 39 is included in Group I. Applicants respectfully request that the Examiner confirm the election of claims 37 and 38 as Group V, and that she also confirm that claim 39 is indeed properly included in Group I which may be prosecuted at a later date.

Early consideration and allowance of claims 37, 38, and 55-68 in the present application is earnestly requested.

Respectfully submitted,

Darwin J. Prockop, et al.

May 25, 1999
(Date)

By:

Kathryn Doyle
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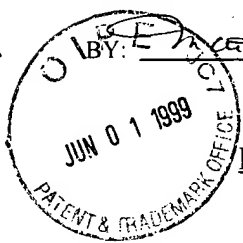
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BY: E. H. La O. Helent

DATE: May 25, 1999

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of : Group Art Unit 1651
Darwin J. Prockop *et al.* :

Appln. No: 08/913,918 : Examiner: Jean C. W

Filed: December 8, 1997 :

Title: ISOLATED STROMAL CELLS AND :
METHODS OF USING SAME : (TJU-1857)

Attorney Docket

No. 9855-14U1

RECEIVED

JUN 03 1999

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AMENDMENT COVER SHEET

Transmitted herewith is a Response to Restriction Requirement along with a Preliminary Amendment accompanying this Response in the above identified application.

☒ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is

☒ already on file;

☐ enclosed.

☐ No additional fee is required.

☐ An Information Disclosure Statement with one copy of each of the cited patents is also attached.

The fee has been calculated as shown below:

| | | | | | SMALL ENTITY | | LARGE ENTITY | |
|---|---|-----|---------------------------------------|------------------|--------------|--------------|--------------|---------------|
| | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NO. PREVIOUSLY PAID FOR | PRESENT EXTRA | RATE | ADDIT FEE | RATE | ADDIT. FEE |
| TOTAL | 68 | (-) | 54 or 20 | = 14 | X9 | \$126.00 | X18 | \$ |
| INDEP. | 7 | (-) | 7 or 3 | = 0 | X39 | \$ -0- | X78 | \$ |
| 1ST PRESENTATION OF MULTIPLE DEPENDENT CLAIMS | | | | | + \$130 | \$ | +\$260 | \$ |
| | | | | | TOTAL | \$126.00 | TOTAL | \$ |

☒ The applicants hereby petition for any extension of time which may be required in connection with the filing of the enclosed paper. **(Petition and Fee for (1) one month extension is enclosed.)**

☒ The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 16-0235. One additional copy of this sheet is attached for accounting purposes.

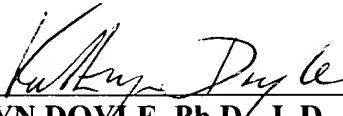
☒ The above calculated additional claim fees **\$126.00**.

☒ Any additional fees under 37 CFR 1.16 or 1.17.

Respectfully submitted,

May 25, 1999
(Date)

By:


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